



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**GROUP 3600**

Appellants: Jay S. Walker,  
Bruce Schneier,  
James A. Jorasch

Application No.: 09/112,131

Filed: July 8, 1998

For: METHOD AND APPARATUS FOR  
A CRYPTOGRAPHICALLY-  
ASSISTED COMMERCIAL  
NETWORK SYSTEM DESIGNED  
TO FACILITATE AND SUPPORT  
EXPERT-BASED COMMERCE

)  
) Group Art Unit: 3629  
)  
) Examiner: C. Nguyen  
)  
) **APPEAL BRIEF**  
)  
) Attorney Docket No. 96-002-C1  
)  
) Customer No. 22927  
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Dated: September 23, 2003 By:

*Veronika S. Leliever*  
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**BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Examiner:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from  
the decision of the Examiner in the Office Action mailed December 18, 2002 (Paper No. 34),  
rejecting claims 177 - 189 and 195.

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**APPENDIX A: CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL**

**APPENDIX B: CHART SHOWING CLAIM DEPENDENCIES**

**APPENDIX C: CHART SHOWING GROUP DEPENDENCIES**

## REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, 1177 High Ridge Road, Stamford, CT 06905.

## RELATED APPEALS AND INTERFERENCES

Appellants are not aware any appeals, which might be considered to directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal:

## STATUS OF CLAIMS

Claims 177 - 189 and 195 are pending in the present application

Claims 177 - 189 are being appealed. Claim 195 has been canceled in an amendment filed concurrently herewith.

A. Claims 177 – 189 and 195 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

B. Claims 177 – 189 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of:

- undocumented and unsupported assertions regarding the operations and / or documents of the U.S. Patent and Trademark Office ("USPTO");
- undocumented and unsupported assertions regarding the Yellow Pages;
- U.S. Patent No. 5,619,648 to Canale et al; and
- U.S. Patent No. 4,576,579 to Harte.

D. Claims 177 – 179 and 185 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,724,580 to Levin.

## STATUS OF AMENDMENTS

An amendment was filed concurrently with this Appeal Brief, canceling rejected claim 195.

## SUMMARY OF INVENTION

Generally, an embodiment of the invention allows an expert seeking to sell his services to more efficiently find a client, and furthermore allows the client to certify and authenticate the expert's qualifications. The client can hire the expert. If desired by either party, payment can be guaranteed to the expert for the expert services to be provided, while also guaranteeing the buyer's satisfaction with the expert service. Present Application, "Summary of the Invention", page 13, lines 9 - 15.

Generally, according to an embodiment of the invention, candidate experts submit detailed applications in advance of receiving any job requests, providing detailed qualifications in one or more areas of expertise along with third party references.

Generally, according to an embodiment of the invention, each application may be reviewed by a certification committee familiar with the subject area(s) being applied for, and the candidate is either accepted or rejected as a qualified expert. Once there are enough experts in a given subject, each new application may be reviewed by other experts who are already members. This provides a basis for peer review that can be used to maintain assurance of qualifications. Present Application, "Summary of the Invention", page 16, lines 6 - 13. See also, "Detailed Description of the Invention", page 38, lines 1 - 12.

Generally, according to an embodiment of the invention, a quality monitoring feature is provided. If the user is dissatisfied with a response, the request is forwarded to another qualified expert for review. This peer review either accepts or rejects the response, and appropriate action may be taken. Present Application, "Summary of the Invention", page 21, lines 8 - 11.

## ISSUES

Whether claims **177 – 189** have been shown to be unpatentable under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Whether claims **177 – 189** have been shown to be unpatentable under 35 U.S.C. § 103(a) over a combination of:

- undocumented and unsupported assertions regarding the operations and / or documents of the U.S. Patent and Trademark Office ("USPTO");
- undocumented and unsupported assertions regarding the Yellow Pages;
- U.S. Patent No. 5,619,648 to Canale et al; and
- U.S. Patent No. 4,576,579 to Harte.

Whether claims **177 – 179 and 185** have been shown to be unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,724,580 to Levin.

## GROUPING OF CLAIMS

The claims in different groups do not stand and fall together.

Appellants group the pending claims as follows:

- Group I - claim **177**;
- Group II - claim **178**;
- Group III - claim **179**;
- Group IV - claims **180 - 184**;
- Group V - claim **185**; and
- Group VI - claims **186 - 189**.

Appellants believe that claims in different groups are separately patentable, as explained below.

## ARGUMENT

As explained below, the Examiner's rejection of the claims is improper at least because the Examiner has failed to set forth the required prima facie case of unpatentability of any claim. The Examiner has not shown the claims to be directed to nonstatutory subject matter. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references of record, alone or in combination. Further, various rejections are based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

In addition, regardless of the failure to present a prima facie case, the cited references, whether alone or in any combination, cannot be interpreted in a manner that would render any pending claim obvious.

Accordingly, the rejections are inappropriate and Appellants respectfully request that the Examiner's rejections be reversed.

In the arguments herein, limitations of the claims are indicated in *italics*, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

## The References

The Examiner has relied on a combination of references in the rejection of all claims. However, the references cited by the Examiner, either alone or in combination, do not disclose or suggest all of the limitations of any claim.

Discussed immediately below are the references used in rejecting the appealed claims: Harte, Levin and Canale.



### **The Harte patent**

In summary, Harte discloses an apparatus using elastic and electroconductive sheets which can provide students with immediate feedback as to correct and incorrect responses on a test. Col. 1, lines 6 - 12.

A grid of holes of two different depths, with electroconductive material at the bottoms of each hole. The electroconductive material can be contacted by an electroconductive stylus. When the stylus is pushed through "response areas" that represent correct and incorrect answers, electric circuits are completed and activated when the stylus touches the electroconductive material that is at the bottom of holes. Col. 1, lines 13 - 22.

The electrical contact or switches are closed at two different depths. One depth indicates that a correct response was made, and the other depth indicates that an incorrect response was made. Col. 1, lines 22 - 27; Col. 1, lines 35 - 41; Col. 4, line 47 - Col. 5, line 3.

This apparatus can be connected with one or more electrical mechanisms (e.g., a computer) that give immediate feedback to the student as to his or her correct and incorrect responses. Col. 1, lines 41 - 50. The computer can also record and retain in its memory the performance of each student on each instructional sheet, and the date and sequence of the instructional sheets to which the student has responded. This information can then be analyzed in various ways and this information fed back to the student and/or teacher. Col. 1, lines 55 - 60; Col. 4, lines 13 - 19; FIG. 8.

### **The Levin patent**

In summary, Levin discloses a system for diagnosis and treatment of coronary disease in which a cardiac specialist, when desired or necessary, may be consulted.

All known information (e.g., ECG information, coronary status, blood pressure, known allergic conditions) from the patient is input into monitor 132 by medical personnel at primary physician's office 120. Col. 5, lines 2 - 18. Alternatively, the patient may be at home, rather than at a primary care physician. Col. 10, lines 30 - 35.

The patient information is then transmitted to centralized data management 122. Col. 5, lines 18 - 25. Devices at the centralized data management 122 can provide a printout representing the desired comprehensive report and course of treatment. Col. 5, lines 30 - 43.

It may be desirable to consult a specialist's office 124 before generating the comprehensive management and prognosis report, or to confirm the written report. Col. 5, lines 49 - 52; Col. 7, lines 53 - 55. Accordingly, centralized data management 122 can transmit information to the specialist's office 124. Col. 5, lines 52 - 60. For example, consultation may be desirable under the patient conditions described in Col. 7, lines 33 - 45.

The specialist's office 124 may then alter the report, and transmit it back to centralized data management center 122, and to primary care physician's office 120. Col. 5, line 60 - Col. 6, line 2.

### **The Canale patent**

In summary, Canale discloses an e-mail filtering system, which may also be used for locating expertise in an e-mail system. In this system, the sender of a message specifies a desired area of expertise by means of a list of keywords which are relevant to the area. The list of keywords is included in a "recipient specifier" in the message. Col. 2, lines 28 - 33.

A mail filter for a potential recipient of messages has access to document files of the potential recipient, and to a list of the e-mail messages sent and received by the potential recipient. The mail filter uses the document files to determine the recipient's areas of expertise. Col. 2, lines 33 - 39. A "user expertise list" 301 is a file containing a list of keywords that describe some of the user's own areas of expertise. Col. 7, lines 31 - 33.

If the keywords in the recipient specifier match one of the areas of expertise, the mail filter provides the e-mail message to the potential recipient; if not, the mail filter uses the list of e-mail messages to determine correspondents of the potential recipient who may have the area of expertise specified in the recipient specifier, and forwards the message to those correspondents. Col. 2, lines 39 - 48. This may be done through a "colleague list" 201, which contains entries 203. Each entry contains an identification 205 of the colleague and a list of keywords 207 describing the colleague's areas of expertise. Col. 7, lines 9 - 12.

### **Other Subject Matter Without Support in the Record is not Substantial Evidence**

Certain rejections under 35 U.S.C. § 103(a) are based on assertions by the Examiner which are unsupported by the record. Appellants have requested documentary support for such assertions per MPEP 2144.03. See, e.g.,

- Appellants' AMENDMENT & RESPONSE, mailed October 1, 2002, page 10 (regarding USPTO operations and / or documents)
- Appellants' AMENDMENT & RESPONSE, mailed April 6, 2001, page 3, footnote 1 (regarding USPTO operations and / or documents)
- Appellants' AMENDMENT & RESPONSE, mailed October 1, 2002, page 8 (regarding eBay.com);
- Appellants' AMENDMENT & RESPONSE, mailed October 1, 2002, page 9 (regarding eBay.com);
- Appellants' AMENDMENT & RESPONSE, mailed October 1, 2002, page 12 (regarding Yellow Pages)

The Examiner has not provided any evidence in support of these assertions, and has not even addressed Appellants' request for such evidence. Thus, there is no evidence in the record which indicates the state of such subject matter, much less the state prior to the priority date of the present application.

The present application is a continuation of U.S. Patent Application No. 08/685,706, which was filed July 24, 1996. Accordingly, the priority date for the present application is not later than July 24, 1996.

Appellants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. The references of record (as well as all other evidence in the record) do not support the Examiner's broad assertions as to what was well known prior to the appropriate priority date.

Accordingly, the Examiner's assertions which are not supported by the references of record lack substantial evidence, and therefore cannot be used as prior art to the present application.

#### Applicable Law of Substantial Evidence

Only the content of the references of record which are prior art to the present application may be used in a prior art rejection. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re

Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

In particular, too the extent such extra-record assertions might be deemed official notice, officially-noted subject matter cannot be used as the **basis** for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference teaching**." ) (emphasis added).

In other words, official notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference** work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge." ) (emphasis added); In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice**." ) (emphasis added); In re Pardo, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art") (emphasis added)

## **1. Group I**

Group I includes independent claim 177.

As discussed below, the rejection of the claims of Group I is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group I. The Examiner has not shown the claims to be directed to non-statutory subject matter. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group I can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group I obvious.

### **1.1. Independent Claim 177**

Independent claim 177 is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert.

A second expert that has a second expert qualification is selected. The second expert qualification is higher than the first expert qualification.

The first expert qualification is transmitted to the second expert. A signal is received from the second expert. This signal indicates approval of the first expert qualification.

### **1.2. Advantages of Independent Claim 177**

The embodiment of claim 177 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages render the claimed subject matter nonobvious over the cited art.

*Group I*

As discussed in the present application, by *selecting a second expert that has a second expert qualification which is higher than the first expert qualification [of a first expert]*, a higher level expert may be located.

By *transmitting the first expert qualification to the second expert*, the second expert is in a position to evaluate the qualifications of the first (lower level) expert.

By *receiving a signal from the second expert that indicates approval of the first expert qualification*, one can receive the approval of the first expert by the second expert.

Thus, the method recited in claim 177 may be used, when evaluating an expert, to find a higher-level expert and then receive from that higher-level expert an indication of whether the first expert is approved. Such a method is extremely useful in, e.g., allowing experts to sell their services to clients that do not know them, allowing clients to trust experts selling services, and generally facilitate commerce in expert advice and services.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

### **1.3. No Prima Facie Showing of Obviousness of the Claims of Group I**

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. In fact, the Examiner has not even referred to or otherwise addressed most of the particular limitations of the claims. As best as Appellants understand the rejections and the asserted prior art, the Examiner has summarily dismissed the pending claims as merely directed to a system in which two experts are involved.

Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

#### Applicable Law

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of

#### ***Group I***

obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). The secondary considerations are also essential components of the obviousness determination. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

When a rejection is based on a combination of references, the Examiner can satisfy the prima facie burden only by showing some objective teaching leading to the purported combination of references. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Lacking a motivation to combine references, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367 (Fed. Cir. 2000). The "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." In re Morris, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

**1.3.1. No showing that the references suggest *selecting a second expert that has a second expert qualification which is higher than the first expert qualification [of a first expert for which a first expert qualification was received]***

The Examiner has not shown that the references, alone or in combination, suggest

***Group I***

*selecting a second expert that has a second expert qualification which is higher than the first expert qualification [of a first expert for which a first expert qualification was received]*

As best as Appellants understand the rejection, the closest the Examiner comes to discussing this limitation is a conclusory statement that:

"USPTO also suggest these claims limitations because they 'read on' analogous steps of 'expert matching'. ... A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices [sic] from his SPE (second expert); this 2<sup>nd</sup> expert approves who would be an appropriate person in his art unit for the job of examining this particular case ... he appoints one of his examiner [sic] who is [an] expert in this specific field"

Office Action mailed December 18, 2002, page 13, par. 9.B.

The Examiner has also asserted that Levin, FIG. 2, element 120 discloses or suggests such a limitation. Office Action mailed December 18, 2002, page 14, par. 10.

#### No Substantial Evidence

First, as described above in the section entitled "The References", there is no evidence in the record for the USPTO material, despite repeated requests from Appellants.

Accordingly, the evidence in the record does not support the Examiner's broad assertions as to what was well known prior to the appropriate priority date. Accordingly, the Examiner's assertions lack substantial evidence, and therefore cannot be used as prior art to the present application.

Only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

#### Do Not Suggest the Claim Limitation

More importantly, even if the Examiner's assertions regarding USPTO practice / documents were properly supported by substantial evidence, they would still not suggest this claim limitation.

#### ***Group I***



According to the Examiner's interpretation, in the USPTO, the *first expert* of the claim limitation is the examiner, the *second expert* of the claim limitation is the examiner's SPE. The SPE (*second expert*) "approves who would be an appropriate person in his art unit for the job of examining this particular case" by appointing an examiner (*first expert*).

Clearly, according to the Examiner's interpretation, the *second expert* selects a *first expert*. This situation is in fact typical of many hierarchical relationships, where those with higher skills manage and select among their subordinates with lower skills.

However, it is clearly the opposite of the claim limitation in which *the second expert [with a higher expert qualification] is selected*. The Examiner's example has the *first expert* being selected by the *second expert*.

Moreover, it would be nonsensical to argue that the *second expert* (SPE) somehow selects himself.

If the opposite interpretation is attempted (though the Examiner has not so proposed and such an interpretation would be a new basis for rejection), it would equally fail to suggest the claim limitation. If the *second expert* was the examiner, who was selected by the SPE, this second expert (examiner) would not have an *expert qualification which is higher than the first expert*, as required by the claim limitation.

In fact, nothing in the PTO operations would suggest that, after a *first expert qualification is received*, a *second expert [with a higher qualification] is selected*.

With respect to Levin, that reference does not deal at all with *selecting* any specialist or expert, much less *selecting an expert that has a higher qualification than another expert qualification that was received*. In contrast, in Levin it is assumed that there is a single cardiologist specialist. Levin does not at all suggest that there may be more than one specialist, and that one would "select" among them for any reason. In fact, the convention in the field is to have one particular specialist to consult.

The Examiner specifically refers to FIG. 2, element 120 of Levin. However, this is merely primary care physician's office, and reference numeral 124 designates the cardiologist's office. The existence of these two collaborating doctors does nothing to suggest that *an expert* is in any way *selected*.

**Group I**

Thus, in summary, the Examiner has not shown that the references, alone or in combination, suggest *selecting a second expert that has a second expert qualification which is higher than the first expert qualification [of a first expert for which a first expert qualification was received]*.

**1.3.2. No showing that the references suggest *transmitting the first expert qualification to the second expert***

The Examiner has not shown that the references, alone or in combination, suggest *transmitting the first expert qualification to the second expert*

As best as Appellants understand the rejection, the closest the Examiner comes to arguing this limitation is a conclusory statement that:

"USPTO also suggest these claims limitations because they 'read on' analogous steps of 'expert matching'. ... A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices [sic] from his SPE (second expert); this 2<sup>nd</sup> expert approves who would be an appropriate person in his art unit for the job of examining this particular case ... he appoints one of his examiner [sic] who is [an] expert in this specific field"

Office Action mailed December 18, 2002, page 13, par. 9.B.

The Examiner has also asserted that Levin, FIG. 2, element 170 discloses or suggests such a limitation. Office Action mailed December 18, 2002, page 14, par. 10.

No Substantial Evidence

First, as described above in the section entitled "The References", there is no evidence in the record for the USPTO material, despite repeated requests from Appellants. Accordingly, the Examiner's assertions lack substantial evidence, and therefore cannot be used as prior art to the present application.

Do Not Suggest the Claim Limitation

*Group I*

More importantly, even if the Examiner's assertions regarding USPTO practice / documents were properly supported by substantial evidence, they would still not suggest this claim limitation.

According to the Examiner's interpretation, in the USPTO, the *first expert* of the claim limitation is the examiner, the *second expert* of the claim limitation is the examiner's SPE.

In this interpretation, there is no indication that any sort of *expert qualification corresponding to* the examiner is received, and no indication that this *expert qualification* of the examiner is *transmitted* to the SPE.

With respect to Levin, that reference does not deal at all with *transmitting any expert qualification* to anyone, much less *transmitting the first expert qualification to the second expert [with the higher qualification]*. In contrast, in Levin the only thing transmitted is patient-related data, such as patient's doctor, sex, glucose levels (col. 5, lines 2 - 6; col. 6, lines 19 - 23) and resulting diagnosis / prognosis reports of the patient (Col. 5, lines 38 - 46, 51 - 55, 60 - 64, 66 - 67).

The Examiner specifically refers to FIG. 2, element 170 of Levin. However, this is merely a communications line. There is no indication that any sort of *expert qualification* is transmitted over this communications line 170. In fact, it would be nonsensical in Levin for the cardiologist to receive the expert qualification of the primary care physician. In Levin, the cardiologist is concerned only with "management of coronary patients based on individual signs and risk factors" by utilizing "all known information both of that particular patient and the patient pool in general". Col. 2, lines 34 - 39.

Thus, in summary, the Examiner has not shown that the references, alone or in combination, suggest *transmitting the first expert qualification to the second expert*.

**1.3.3. No showing that the references suggest *receiving a signal from the second expert that indicates approval of the first expert qualification***

The Examiner has not shown that the references, alone or in combination, suggest

***Group I***

*receiving a signal from the second expert that indicates approval of the first expert qualification*

As best as Appellants understand the rejection, the closest the Examiner comes to arguing this limitation is a conclusory statement that:

"USPTO also suggest these claims limitations because they 'read on' analogous steps of 'expert matching'. ... A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices [sic] from his SPE (second expert); this 2<sup>nd</sup> expert approves who would be an appropriate person in his art unit for the job of examining this particular case ... depending on the specific subject matter such as insurance, shopping, ... he appoints one of his examiner [sic] who is [an] expert in this specific field"

Office Action mailed December 18, 2002, page 13, par. 9.B.

The Examiner has also asserted that Levin, FIG. 2, elements 160 and 166 discloses or suggests such a limitation. Office Action mailed December 18, 2002, page 14, par. 10.

#### No Substantial Evidence

First, as described above in the section entitled "The References", there is no evidence in the record for this material, despite repeated requests from Appellants. Accordingly, the Examiner's assertions lack substantial evidence, and therefore cannot be used as prior art to the present application.

#### Do Not Suggest the Claim Limitation

More importantly, even if the Examiner's assertions regarding USPTO practice / documents were properly supported by substantial evidence, they would still not suggest this claim limitation.

According to the Examiner's interpretation, in the USPTO, the *first expert* of the claim limitation is the examiner, the *second expert* of the claim limitation is the examiner's SPE.

In this interpretation, there is no indication that this *expert qualification* of the examiner is *transmitted* to the SPE, and no indication that any sort of *signal is received from* the SPE which *indicates approval of the expert qualification of* the examiner. There is no need for the SPE to "approve" (or disapprove) of the expert qualifications of the examiner. One wonders

***Group I***

what would happen if the SPE in fact could approve or disapprove of the expert qualifications of an examiner.

With respect to Levin, that reference does not deal at all with *receiving from* any specialist or expert anything at all like an *approval*, much less *receiving from the specialist anything that indicates approval of the* primary care physician. In contrast, in Levin the only thing transmitted is patient-related data, such as patient's doctor, sex, glucose levels (col. 5, lines 2 - 6; col. 6, lines 19 - 23) and resulting diagnosis / prognosis reports of the patient (Col. 5, lines 38 - 46, 51 - 55, 60 - 64, 66 - 67).

The Examiner specifically referred to FIG. 2, elements 160 and 166 of Levin. However, these are merely communications lines. There is no indication that any sort of *expert qualification* or *approval thereof* is transmitted over these communications lines. In fact, it would be nonsensical in Levin for the cardiologist to receive the expert qualification of the primary care physician and somehow indicate *approval* of the expert qualification. In Levin, the cardiologist is concerned only with "management of coronary patients based on individual signs and risk factors" by utilizing "all known information both of that particular patient and the patient pool in general". Col. 2, lines 34 - 39.

Thus, in summary, the Examiner has not shown that the references, alone or in combination, suggest *receiving a signal from the second expert that indicates approval of the first expert qualification*.

#### **1.3.4. No showing of a proper motivation to combine the references**

The Examiner simply has not shown a motivation in the prior art of record to modify or combine the disparate references in the way suggested by the Examiner, or in any other manner that renders the claims obvious.

#### **Applicable Law**

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

***Group I***

motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. Id. The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. Id., at 1352 - 53.

#### Asserted Factual Findings

The Examiner has provided one motivation to modify the USPTO assertions, and one motivation to modify Levin.

It is asserted that one of ordinary skill in the art at the time the invention was made would:

"implement the same concept of managing different skills in USPTO organization, with Canale/Yellow Pages, and Harte's suggestions to perform functions as claimed; because USPTO applying [sic] an analogous concept as a [sic] expert matching to select an appropriate source for a specific solution. A motivation for proper managing [of] an expert's SKILL is to achieve maximum results for [the] agency's plans"

Office Action mailed December 18, 2002, page 14, par. 9.B.

It is also asserted that one of ordinary skill in the art at the time the invention was made would:

#### ***Group I***

"implement the same concept of communication of different skills in Levin's patent to achieve a specific need as claimed; because Levin applying [sic] an analogous concept as a [sic] expert matching to select an appropriate source for a specific solution. A motivation for proper communication for [sic] an expert's SKILL is to achieve maximum results for a specific need."

Office Action mailed December 18, 2002, page 15, par. 10.

As best as Appellants can understand the above reasoning, each motivation fails for at least two reasons:

- (a) the motivation would not actually have prompted one to make the proposed combination or modification; and
- (b) the proposed combination or modification has nothing to do with the embodiment of claim 177, as discussed above in Sections 1.3.1, 1.3.2 and 1.3.3.

Appellants note that, as discussed above, the U.S. Patent and Trademark Office matter is not properly of record, and thus cannot be a basis for any factual finding regarding a motivation to combine or modify the prior art. Nevertheless, even if such subject matter were of record, it would still not provide a proper motivation to combine or modify the prior art.

With respect to reason (a), the first motivation, "to select an appropriate source for a specific solution" or "managing an expert's skill", would not cause one to seek out the USPTO or any other hierarchical organizational structure in which superiors delegate to subordinates.

Further with respect to reason (a), the second motivation, "to select an appropriate source for a specific solution" or "communication of an expert's skill", would not cause one to seek out the diagnosis system of Levin, which has nothing to do with selection of anything, much less "appropriate sources" of expert information.

With respect to reason (b), the first and second modifications (as well as any combination of the references) have nothing to do with the embodiment of claim 177. As described in Sections 1.3.1, 1.3.2 and 1.3.3 above, any such combination or modification would still lack several limitations of claim 177, would not at all indicate these limitations, and these limitations have significant advantages, as explained above in Section 1.2.

***Group I***

Further, any such combination or modification of the references would not solve any the problems addressed by the embodiment of claim 177 (and the Examiner has not alleged otherwise).

Thus the Examiner has not shown a motivation in the prior art of record to modify or combine the references in any manner that renders the claims of the Group obvious.

### **1.3.5. Nonanalogous References**

#### Applicable Law

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

#### Asserted Factual Findings

Levin is directed to allowing a specialist to provide information and diagnosis for certain patients, rather than requiring referral of a larger number of such patients to the specialist.

Canale is directed to an e-mail filtering system which allows a requester to locate someone who professes to have expertise in a particular area.

Harte is directed to an apparatus which can provide students with immediate feedback as to correct and incorrect responses on a test.

USPTO is not properly of record, but is nevertheless apparently directed to a hierarchical organization in which a superior delegates to a subordinate.

Yellow Pages is not properly of record, but is nevertheless apparently directed to a directory which allows one to locate someone who professes to possess expertise in a particular area.

eBay.com is not properly of record, but is nevertheless apparently directed to an auction system for goods.

None of the above references is in the field of the Appellants' endeavor, and none of the above references is reasonably pertinent to the particular problem addressed by the embodiment of the claims of the Group, or in fact of any other claim.

#### ***Group I***



#### **1.4. The Claims of Group I are Allowable Over the Cited References**

As described above, the Examiner has failed to provide a prima facie showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

##### **1.4.1. The references do not suggest *selecting a second expert that has a second expert qualification which is higher than the first expert qualification [of a first expert for which a first expert qualification was received]***

In addition to the deficiencies described above, no other references (whether properly of record or not) suggest

*selecting a second expert that has a second expert qualification which is higher than the first expert qualification [of a first expert for which a first expert qualification was received]*

Harte has nothing to do with experts or expert qualifications.

eBay.com apparently has nothing to do with experts or expert qualifications.

Canale has nothing to do with *selecting an expert having a higher expert qualification than* anything else. In Canale a query for particular expertise is forwarded through e-mail recipients until reaching a recipient who has indicated having such expertise. There is no *selecting* - the recipient decides whether to respond to this email. More importantly, there is no *selecting an expert that has a higher qualification than* another. In Canale there is no basis for comparing qualifications.

Yellow Pages apparently has nothing to do with selecting an expert having a higher expert qualification. In Yellow Pages there is apparently no basis for comparing qualifications.

##### **1.4.2. The references do not suggest *transmitting the first expert qualification to the second expert [with a higher expert qualification]***

*Group I*

In addition to the deficiencies described above, no other references (whether properly of record or not) suggest

*transmitting the first expert qualification to the second expert [with a higher qualification]*

Harte has nothing to do with experts or expert qualifications.

eBay.com apparently has nothing to do with experts or expert qualifications.

Canale has nothing to do with *transmitting any expert qualification to another expert [with a higher qualification]*. In Canale a query for particular expertise is forwarded through e-mail recipients until reaching a recipient who has indicated having such expertise. In Canale there is no basis for comparing qualification.

Yellow Pages apparently has nothing to do with transmitting expert qualifications to an expert having a higher expert qualification. In Yellow Pages there is apparently no basis for comparing qualification.

### **1.5. No Prima Facie Showing that the Claims of Group I are Nonstatutory**

The Examiner has not provided a proper legal basis for rejecting the claims as non-statutory.

#### Appellants' Understanding of the Standard Used

The Office Action on pages 5 - 6 sets forth several apparent bases for rejection under Section 101. It is Appellants' understanding that the invention claimed is rejected because it:

- a. does "not apply, involve, use the technological arts"
- b. must "unambiguously recite that a machine/apparatus is performing the step(s) and / or is integrally involved in the process for the achieved effect"

#### The Proper Legal Standard under Section 101

Whether a patent claim is directed to statutory subject matter under 35 U.S.C. § 101 is a question of law. AT & T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1355, 1359, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). The legal test for the presence of statutory subject matter

#### ***Group I***

is only that a claimed process or apparatus produce a "useful, concrete and tangible result". See, e.g., State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1375, 47 U.S.P.Q.2D 1596 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093, 142 L. Ed. 2d 704, 119 S. Ct. 851 (1999) ("For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a 'useful, concrete, and tangible result.' ... This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss."); AT & T Corp. v. Excel Communications, Inc., ("the focus is understood to be not on whether there is a mathematical algorithm at work, but on whether the algorithm-containing invention, as a whole, produces a tangible, useful, result."); See also, State Street Bank at 1373 ("In Alappat, we held that data, transformed by a machine through a series of mathematical calculations to produce a smooth waveform display on a rasterizer monitor, constituted a practical application of an abstract idea ... because it produced 'a useful, concrete and tangible result'--the smooth waveform); See also, State Street Bank at 1373 ("in Arrhythmia Research Technology Inc. ... , we held that the transformation of electrocardiograph signals from a patient's heartbeat by a machine through a series of mathematical calculations constituted a practical application of an abstract idea ... because it corresponded to a useful, concrete or tangible thing--the condition of a patient's heart").

While other criteria, if satisfied, may be useful in indicating the presence of a "useful, concrete and tangible result" (and therefore indicate that a claim is statutory), the absence of such criteria does not preclude a finding of statutory subject matter. Such other criteria are not requirements, but merely some of several ways that can demonstrate that an invention produces a useful, concrete and tangible result.

For example, a physical transformation by a claimed process is one example (but not a requirement) of how a mathematical algorithm may bring about a useful application. AT & T Corp. v. Excel Communications, Inc., 172 F.3d at 1357, 50 USPQ2d at 1452. See also, Diehr, 450 U.S. at 192 (the "e.g." signal denotes that physical transformation is an example, not an exclusive requirement for satisfying § 101); Arrhythmia Research Tech., 958 F.2d at 1060, 22 USPQ2d at 1039 (Fed. Cir. 1992) (the transformation simply confirmed that Arrhythmia's method claims satisfied § 101 because the method produced a number which had specific meaning - a useful, concrete, tangible result - not a mathematical abstraction).

***Group I***

Likewise, physical limitations are perhaps helpful, but are not necessary to render a claim statutory. AT & T Corp. v. Excel Communications, Inc., 172 F.3d at 1359 ("Whatever may be left of the earlier test, if anything, this type of physical limitations analysis seems of little value ...")

Certain features are not helpful to the proper analysis, and have no bearing on the presence of statutory subject matter. For example, whether a result of a claim is expressed in numbers makes no difference. State Street Bank, 149 F.3d at 1374, 47 USPQ2d at 1602 ("[E]ven if the useful result is expressed in numbers, such as price, profit, percentage, cost or loss", the invention that produces that result is statutory); Arrhythmia Research Tech. Inc. v. Corazonix Corp., 958 F.2d 1053, 1060, 22 U.S.P.Q.2D 1033, 1039 (Fed. Cir. 1992) ("That the product is numerical is not a criterion of whether the claim is directed to statutory subject matter."). When a mathematical algorithm included within a claimed process is "applied to produce a number which had specific meaning - a useful, concrete, tangible result - not a mathematical abstraction", that process claim satisfies § 101. AT & T Corp. v. Excel Communications, Inc., 172 F.3d at 1357, 50 USPQ2d at 1452, citing Arrhythmia Research Tech. v. Corazonix Corp., 958 F.2d 1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992).

Under the proper standard, claims have been found statutory because they produced useful results such as "a final share price", State Street Bank, 149 F.3d at 1373, 47 USPQ2d at 1601, a "value of a PIC indicator" which represents "information about the call recipient's PIC", AT & T Corp. v. Excel Communications, Inc., 172 F.3d at 1357, 50 USPQ2d at 1452; and a condition of a patient's heart, Arrhythmia Research Tech. v. Corazonix Corp., 958 F.2d 1053.

The threshold for utility is not high – an invention is “useful” under Section 101 if it is capable of providing some identifiable benefit. Juicy Whip Inc. v. Orange Bang Inc., 185 F.3d 1364, 51 U.S.P.Q.2d 1700 (Fed. Cir. 1999).

#### The Claims Meet the Standard for Statutory Subject Matter

All pending claims produce a useful, concrete and tangible result. The claims of Group I include the limitation of *receiving a signal from the second expert that indicates approval of the first expert qualification*. As explained in the Present Application, *such approval from such a [higher level] expert* results in a useful, concrete and tangible result – a validation of the qualification of a [lower level] expert, and thus an increased trust in that expert's services. In

#### ***Group I***

certain disclosed embodiments, the use of such approval can facilitate commerce in experts selling their services.

The receipt of such a signal is not an abstract, disembodied idea, but instead has a specific meaning and corresponds to a useful, concrete or tangible result - something which indicates whether a higher level expert approves of the qualification of lower level expert. The processes claimed can by no stretch of the imagination be classified as "abstract ideas" and are thus properly defined statutory processes.

In this respect, in the pending claims the *signal indicating approval* renders the claims statutory for much the same reason the "signal related to the patient's heart activity" rendered the claims statutory in Arrhythmia Research Tech.:

"[I]n Arrhythmia Research Technology Inc. v. Corazonix Corp., 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992), we held that [the method and apparatus claims] constituted a practical application of an abstract idea (a mathematical algorithm, formula, or calculation), because it corresponded to a useful, concrete or tangible thing--the condition of a patient's heart."

State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d at 1373.

Using similar reasoning, in the pending claims the *signal indicating approval* likewise corresponds to a useful, concrete or tangible thing - a [higher level] expert's assessment of the qualifications of another [lower level] expert.

It is also worth noting that the requirement for a "useful invention" is to be evaluated for the **invention**, and is not dependent on the breadth of the claims. Thus, if one species of an invention claimed as a genus is found to be "useful", utility for the genus is established. Raytheon Co. v. Roper Corp., 724 F.2d 951, 958, 220 USPQ 592, 598 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984) ("When a properly claimed invention meets at least one stated objective, utility under § 101 is clearly shown."). Utility is to be evaluated in a simple "yes" or "no" fashion (i.e., does the invention as claimed possess or not possess utility). There is no subjective test for "utility" that must be deemed to be commensurate with the breadth of the claims being sought to be patented.

Moreover, the scope of the claims as presented encompass a variety of specific implementations of the claimed processes. Certain of these embodiments implicate the use of devices (such as computers) in the processes. These "computer-based" species clearly fall within the broader generic definition of the claimed processes. Given that utility for a genus may be

established through a recitation of utility of a species within that genus, a rejection that the generically claimed processes lack utility is clearly improper.

Rejection is Based Upon Improper Legal Standard(s)

It is clear that the rejection is not predicated upon the proper legal test, discussed immediately above. The Office Action includes no inquiry into the existence of a useful, concrete and tangible result.

Instead, the rejection is predicated upon reasons with no basis in law. There is no requirement to "apply, involve, use the technological arts" (whatever those terms may mean). There is similarly no requirement to "unambiguously recite that a machine/apparatus is performing the step(s)" of a method claim.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group I, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group I, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 1.2 "Advantages of Independent Claim 1". Further, the Examiner has not presented an appropriate legal basis to hold the claims to be nonstatutory. Accordingly, for at least those reasons, the claims of Group I are patentable.

## **2. Group II**

### **SEPARATE ARGUMENT OF PATENTABILITY**

Group II includes independent claim 178. Independent claim 178 includes all of the limitations of independent claim 177, discussed above in Group I. Accordingly, all arguments above with respect to Group I are equally applicable to Group II, and the claims of Group II are patentable at least for the same reasons given above for Group I. Moreover, additional arguments are provided below for the patentability of the claims of Group II, regardless of the patentability of the claims of Group I.

As discussed below, the rejection of the claims of Group II is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group II. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group II can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group II obvious.

#### **2.1. Independent Claim 178**

Independent claim 178 is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert.

A second expert that has a second expert qualification is selected. The second expert qualification is higher than the first expert qualification.

The first expert qualification is transmitted to the second expert. A signal is received from the second expert. This signal indicates approval of the first expert qualification. Identity data of the second expert is incorporated into a key of the first expert.

***Group II***

## **2.2. Advantages of Independent Claim 178**

In addition to the advantages discussed above in Section 1.2 with respect to Group I, the embodiment of claim 178 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

By *incorporating identity data of the second expert into a key of the first expert*, the first expert may demonstrate approval by one or more higher-level experts, and may also demonstrate the identity of each such higher-level expert. Such a key may be, e.g., provided with the answers that the expert creates. Accordingly, such a key could provide customers of the expert with assurances that the expert was approved.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

## **2.3. No Prima Facie Showing of Unpatentability of the Claims of Group II**

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

### **2.3.1. No showing that the references suggest *incorporating identity data of the second expert into a key of the first expert***

Appellants can find no discussion in the rejection of claim 178 which could be interpreted as pertaining to the claim limitation of:

*incorporating identity data of the second expert into a key of the first expert*

Accordingly, the Examiner has not provided a prima facie case of unpatentability of this claim.

***Group II***



## **2.4. The Claims of Group II are Allowable Over the Cited References**

As described above, the Examiner has failed to provide a *prima facie* showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

### **2.4.1. The references do not suggest *incorporating identity data of the second expert into a key of the first expert***

No reference suggests:

*incorporating identity data of the second expert into a key of the first expert.*

No reference has anything to do with incorporating identity data of an expert in any way, much less in a key, much less in a key of another [lower level] expert.

## **2.5. No Prima Facie Showing that the Claims of Group II are Nonstatutory**

The discussion above in Section 1.5 is equally applicable to the claims of this Group.

In addition, *incorporating identity data of the second expert into a key of the first expert* is a further useful, concrete and tangible result. As explained in the Present Application, such a key can allow an expert to demonstrate approval by one or more higher-level experts. Such a key may also demonstrate the identity of each such higher-level expert. Such a key may be, e.g., provided with the answers that the expert creates. Accordingly, such a key could provide customers of the expert with assurances that the expert was approved.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group II, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group II, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 2.2

***Group II***

"Advantages of Independent claim 178". Accordingly, for at least those reasons, the claims of Group II are patentable in view of the cited references.

***Group II***

### **3. Group III**

#### **SEPARATE ARGUMENT OF PATENTABILITY**

Group III includes independent claim 179.

As discussed below, the rejection of the claims of Group III is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group III. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group III can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group III obvious.

#### **3.1. Independent Claim 179**

Independent claim 179 is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert.

The first expert qualification is submitted for review by a set of experts that each have a qualification that is higher than the first expert qualification. A signal is received from the set of experts that indicates approval of the first expert qualification.

An end user request is received from an end user, and the first expert is selected based on the end user request.

At least a portion of the end user request is transmitted to the first expert. An expert answer is received responsive to the end user request. The expert answer contains information about the second expert. The expert answer is transmitted to the end user.

*Group III*

### 3.2. Advantages of Independent Claim 179

The embodiment of claim 179 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages render the claimed subject matter nonobvious over the cited art.

*By submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification, and also by receiving a signal from the set of experts that indicates approval of the first expert qualification, the expert who is to provide an expert answer may be reviewed. Thus, the expert's answer is more trusted by the end user. Accordingly, customers of the expert have assurances about the expert.*

*By transmitting at least a portion of the end user request to the first expert, and receiving an expert answer responsive to the end user request, the end user's request can be answered by an expert. This can be useful, e.g., in a system in which experts sell their advice, possibly anonymously.*

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

### 3.3. No Prima Facie Showing of Unpatentability of the Claims of Group III

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

#### 3.3.1. No showing that the references suggest *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification*

The Examiner has not shown that the references, alone or in combination, suggest *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification*

**Group III**

As best as Appellants understand the rejection, the closest the Examiner comes to arguing this limitation is a conclusory statement that:

"USPTO also suggest these claims limitations because they 'read on' analogous steps of 'expert matching'. ... A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices [sic] from his SPE (second expert); this 2<sup>nd</sup> expert approves who would be an appropriate person in his art unit for the job of examining this particular case ... he appoints one of his examiner [sic] who is [an] expert in this specific field"

Office Action mailed December 18, 2002, page 13, par. 9.B.

The Examiner has also apparently asserted that Levin, FIG. 2, element 170 discloses or suggests such a limitation. Office Action mailed December 18, 2002, page 14, par. 10.

#### No Substantial Evidence

First, as described above in the section entitled "The References", there is no evidence in the record for the USPTO material, despite repeated requests from Appellants. Accordingly, the Examiner's assertions lack substantial evidence, and therefore cannot be used as prior art to the present application.

#### Do Not Suggest the Claim Limitation

More importantly, even if the Examiner's assertions regarding USPTO practice / documents were properly supported by substantial evidence, they would still not suggest this claim limitation.

According to the Examiner's interpretation, in the USPTO, the *first expert* of the claim limitation is the examiner, the *second expert* of the claim limitation is the examiner's SPE.

In this interpretation, there is no indication that any sort of *expert qualification corresponding to* the examiner is received, and no indication that this *expert qualification of the* examiner is *submitted* to the SPE.

Moreover, there is no indication that any sort of *expert qualification* of the examiner is submitted *for review by a set of* SPEs or anyone else.

#### ***Group III***

With respect to Levin, that reference does not deal at all with *submitting any expert qualification* to anyone, much less *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification*. In contrast, in Levin the only thing which might be submitted is patient-related data, such as patient's doctor, sex, glucose levels (col. 5, lines 2 - 6; col. 6, lines 19 - 23) and resulting diagnosis / prognosis reports of the patient (col. 5, lines 38 - 46, 51 - 55, 60 - 64, 66 - 67).

The Examiner specifically referred to FIG. 2, element 170 of Levin. However, this is merely a communications line. There is no indication that any sort of *expert qualification* is transmitted over this communications line 170. In fact, it would be nonsensical in Levin for the cardiologist to receive the expert qualification of the primary care physician. In Levin, the cardiologist is concerned only with "management of coronary patients based on individual signs and risk factors" and utilizing "all known information both of that particular patient and the patient pool in general". Col. 2, lines 34 - 39.

Finally, in Levin there is no *set of experts* who *review the qualification* of another [lower level] expert.

Thus, in summary, the Examiner has not shown that the references, alone or in combination, suggest *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification*.

### **3.3.2. No showing that the references suggest *receiving a signal from the set of experts that indicates approval of the first expert qualification***

The Examiner has not shown that the references, alone or in combination, suggest *receiving a signal from the set of experts that indicates approval of the first expert qualification*

As best as Appellants understand the rejection, the closest the Examiner comes to arguing this limitation is a conclusory statement that:

"USPTO also suggest these claims limitations because they 'read on' analogous steps of 'expert matching'. ... A patent application is transmitted to an examiner (first expert), he

**Group III**

examines the case, and then get some advices [sic] from his SPE (second expert); this 2<sup>nd</sup> expert approves who would be an appropriate person in his art unit for the job of examining this particular case ... depending on the specific subject matter such as insurance, shopping, ... he appoints one of his examiner [sic] who is [an] expert in this specific field"

Office Action mailed December 18, 2002, page 13, par. 9.B.

The Examiner has also asserted that Levin, FIG. 2, elements 160 and 166 discloses or suggests such a limitation. Office Action mailed December 18, 2002, page 14, par. 10.

#### No Substantial Evidence

First, as described above in the section entitled "The References", there is no evidence in the record for this material, despite repeated requests from Appellants. Accordingly, the Examiner's assertions lack substantial evidence, and therefore cannot be used as prior art to the present application.

#### Do Not Suggest the Claim Limitation

More importantly, even if the Examiner's assertions regarding USPTO practice / documents were properly supported by substantial evidence, they would still not suggest this claim limitation.

According to the Examiner's interpretation, in the USPTO, the *first expert* of the claim limitation is the examiner. However, there appears to be no *set of [higher level] experts*.

In this interpretation, there is no indication that this *expert qualification* of the examiner is *transmitted* to the SPE, and no indication that any sort of *signal is received from* the SPE which *indicates approval of the expert qualification of* the examiner. There is no need for the SPE to "approve" (or disapprove) of the expert qualifications of the examiner. One wonders what would happen if the SPE in fact could approve or disapprove of the expert qualifications of an examiner.

With respect to Levin, that reference does not deal at all with *receiving from* any specialist or expert anything at all like an *approval*, much less *receiving from the specialist anything that indicates approval of the* primary care physician. In contrast, in Levin the only

#### **Group III**

thing transmitted is patient-related data, such as patient's doctor, sex, glucose levels (col. 5, lines 2 - 6; col. 6, lines 19 - 23) and resulting diagnosis / prognosis reports of the patient (Col. 5, lines 38 - 46, 51 - 55, 60 - 64, 66 - 67).

There is also no *set of [higher level] experts* in Levin.

The Examiner specifically referred to FIG. 2, elements 160 and 166 of Levin. However, these are merely communications lines. There is no indication that any sort of *expert qualification* or *approval thereof* is submitted over these communications lines. In fact, it would be nonsensical in Levin for the cardiologist to receive the expert qualification of the primary care physician and somehow indicate *approval* of the expert qualification. In Levin, the cardiologist is concerned only with "management of coronary patients based on individual signs and risk factors" and utilizing "all known information both of that particular patient and the patient pool in general". Col. 2, lines 34 - 39.

Thus, in summary, the Examiner has not shown that the references, alone or in combination, suggest *receiving a signal from the set of experts that indicates approval of the first expert qualification*.

### **3.3.3. No showing of a proper motivation to combine the references**

The arguments in Section 1.3.4 above are equally applicable to the lack of motivation to combine or modify the art in any manner which render the claims of the Group obvious.



### 3.3.4. No showing of a proper motivation to combine the references

The arguments in Section 1.3.5 above are equally applicable to the inability to combine or modify the art in any manner which render the claims of the Group obvious.

### 3.4. The Claims of Group III are Allowable Over the Cited References

As described above, the Examiner has failed to provide a prima facie showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

#### 3.4.1. The references do not suggest *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification*

In addition to the deficiencies described above, no other references (whether properly of record or not) suggest

*submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification*

Harte has nothing to do with experts, sets of experts, or expert qualifications.

eBay.com apparently has nothing to do with experts, sets of experts, or expert qualifications.

Canale has nothing to do with *submitting any expert qualification for review by a set of experts [with higher qualifications]*. In Canale a query for particular expertise is forwarded through e-mail recipients until reaching a recipient who has indicated having such expertise. In Canale there is no basis for comparing qualification.

Yellow Pages apparently has nothing to do with transmitting expert qualifications to a set of experts having higher expert qualifications. In Yellow Pages there is apparently no basis for comparing qualification.

### ***Group III***

### **3.5. No Prima Facie Showing that the Claims of Group III are Nonstatutory**

The discussion above in Section 1.5 is equally applicable to the claims of this Group.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group III, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group III, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 3.2 "Advantages of Independent claim 179". Accordingly, for at least those reasons, the claims of Group III are patentable in view of the cited references.

***Group III***

#### **4. Group IV**

##### **SEPARATE ARGUMENT OF PATENTABILITY**

Group IV includes dependent claims **180 - 184**. All these dependent claims depend from independent claim **179**, discussed above in Group III. Accordingly, all arguments above with respect to Group III are equally applicable to Group IV, and the claims of Group IV are patentable at least for the same reasons given above for Group III. Moreover, additional arguments are provided below for the patentability of the claims of Group IV, regardless of the patentability of the claims of Group III.

As discussed below, the rejection of the claims of Group IV is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group IV. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group IV can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group IV obvious.

Claim **180** is discussed below. Remaining claims **181 - 184** depend from claim **180**. Therefore, the discussion below refers only to claim **180**, but all arguments are likewise applicable to the remaining claims of the Group.

##### **4.1. Dependent Claim 180**

Dependent claim **180** is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert.

*Group IV*

The first expert qualification is submitted for review by a set of experts that each have a qualification that is higher than the first expert qualification. A signal is received from the set of experts. This signal indicates approval of the first expert qualification.

An end user request is received from an end user, and the first expert is selected based on the end user request.

At least a portion of the end user request is transmitted to the first expert. An expert answer is received responsive to the end user request. The expert answer contains information about the second expert. The expert answer is transmitted to the end user.

Payment is guaranteed to the first expert.

#### **4.2. Advantages of Dependent Claim 180**

In addition to the advantages discussed above in Section 3.2 with respect to Group III, the embodiment of claim 180 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

By *guaranteeing payment to the first expert*, experts are more willing to attempt to sell their services to end users, and are more willing to invest considerable time in high value services for end users. Thus, *guaranteeing payment to the first expert* overcomes several drawbacks of conventional systems for commerce in expert advice.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

#### **4.3. No Prima Facie Showing of Unpatentability of the Claims of Group IV**

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

#### ***Group IV***

#### **4.3.1. No showing that the references suggest *guaranteeing payment to the first expert***

The Examiner has not shown that the references, alone or in combination, suggest:  
*guaranteeing payment to the first expert*

As best as Appellants understand the rejection, the closest the Examiner comes to discussing this limitation is a conclusory statement that:

"These steps are obviously involved in the test: ... *guaranteeing payment to the selected test (e.g., a test fee is administered in order to take the test or in order to have test results); therefore, the examiner submits that this step is obvious in a placement test*"

Office Action mailed December 18, 2002, pages 10 - 11, par. 9.A.

#### No Substantial Evidence

First, as described above in the section entitled "The References", there is no evidence in the record for the USPTO material, or any other material in which one pays for a test, despite repeated requests from Appellants.

#### Do Not Suggest the Claim Limitation

More importantly, even if the Examiner's assertions were properly supported by substantial evidence, they would still not suggest this claim limitation.

According to the Examiner's interpretation, the payment by a test taker of a test fee suggests the claim limitation of *guaranteeing payment to the first expert*.

First, Appellants' understanding that full payment of test fees are required in advance of the test, otherwise registration is not permitted. There is no *guaranteeing of payment*.

Second, the test taker makes payment to the testing organization. This testing organization, for example, is not an *expert*, and is not *selected based on an end user* request. To the extent the test taker is considered the end user, the test taker does not provide a *request*, and an *expert answer* is not received responsive to any *request*. Finally, though the test taker may submit answers to test questions, the test taker is not an *expert* who thereafter is *guaranteed payment*.

#### ***Group IV***

#### **4.4. The Claims of Group IV are Allowable Over the Cited References**

As described above, the Examiner has failed to provide a *prima facie* showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

##### **4.4.1. The references do not suggest *guaranteeing payment to the first expert***

No reference suggests:

*guaranteeing payment to the first expert*

No reference suggests that payment needs to be guaranteed, that payment is in danger of not being paid, or anything at all analogous to the claim limitation.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group IV, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group IV, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 4.2 "Advantages of Dependent claim 180". Accordingly, for at least those reasons, the claims of Group IV are patentable in view of the cited references.

*Group IV*

## **5. Group V**

### **SEPARATE ARGUMENT OF PATENTABILITY**

Group V includes independent claim **185**. Independent claim **185** includes all of the limitations of independent claim **177**, discussed above in Group I. Accordingly, all arguments above with respect to Group I are equally applicable to Group V, and the claims of Group V are patentable at least for the same reasons given above for Group I. Moreover, additional arguments are provided below for the patentability of the claims of Group V, regardless of the patentability of the claims of Group I.

As discussed below, the rejection of the claims of Group V is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group V. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group V can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group V obvious.

#### **5.1. Independent Claim 185**

Independent claim **185** is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert.

A second expert that has a second expert qualification is selected. The second expert qualification is higher than the first expert qualification.

The first expert qualification is transmitted to the second expert. A signal is received from the second expert. This signal indicates approval of the first expert qualification.

*Group V*

An end user request is received from an end user, and the first expert is selected based on the end user request.

At least a portion of the end user request is transmitted to the first expert. An expert answer is received responsive to the end user request. The expert answer contains information about the second expert. The expert answer is transmitted to the end user.

## **5.2. Advantages of Independent Claim 185**

In addition to the advantages discussed above in Section 1.2 with respect to Group I, the embodiment of claim 185 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

By *selecting the first expert based on a received end user request*, it may be assured that only appropriate experts for the particular request are selected.

By *transmitting at least a portion of the end user request to the first expert, and receiving an expert answer responsive to the end user request*, the end user's request can be answered by an expert. This can be useful, e.g., in a system in which experts sell their advice, possibly anonymously.

Because *the expert answer contains information about the second [higher level] expert*, the first expert may demonstrate approval by one or more higher-level experts, and may also demonstrate the identity of each such higher-level expert. By implication, the expert's answer is more trusted by the end user. Accordingly, customers of the expert have assurances about the expert.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

## **5.3. No Prima Facie Showing of Unpatentability of the Claims of Group V**

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not

*Group V*



disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

**5.3.1. No showing that the references suggest *receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert***

Appellants can find no discussion in the rejection of claim 185 which could be interpreted as pertaining to the claim limitation of:

*receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert*

Accordingly, the Examiner has not provided a prima facie case of unpatentability of this claim.

**5.4. The Claims of Group V are Allowable Over the Cited References**

As described above, the Examiner has failed to provide a prima facie showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

**5.4.1. The references do not suggest *receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert***

No reference suggests:

*receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert.*

No reference suggests that an answer contains anything to do with an expert other than the one providing the answer.

*Group V*

### 5.5. No Prima Facie Showing that the Claims of Group V are Nonstatutory

The discussion above in Section 1.5 is equally applicable to the claims of this Group.

In addition, *receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert* is a further useful, concrete and tangible result. As explained in the Present Application, if *the expert answer contains information about the second expert*, such an answer could allow an expert to demonstrate approval by one or more higher-level experts. Accordingly, such an answer could provide customers of the expert with assurances that the expert was approved.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group V, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group V, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 5.2 "Advantages of Independent claim 185". Accordingly, for at least those reasons, the claims of Group V are patentable in view of the cited references.

## **6. Group VI**

### **SEPARATE ARGUMENT OF PATENTABILITY**

Group VI includes dependent claims **186 - 189**. All these dependent claims depend from independent claim **185**, discussed above in Group V. Accordingly, all arguments above with respect to Group V are equally applicable to Group VI, and the claims of Group VI are patentable at least for the same reasons given above for Group V. Moreover, additional arguments are provided below for the patentability of the claims of Group VI, regardless of the patentability of the claims of Group V.

As discussed below, the rejection of the claims of Group VI is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group VI. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group VI can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group VI obvious.

Claim **186** is discussed below. Remaining claims **187 - 189** depend from claim **186**. Therefore, the discussion below refers only to claim **186**, but all arguments are likewise applicable to the remaining claims of the Group.

#### **6.1. Dependent Claim 186**

Dependent claim **186** is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert.

A second expert that has a second expert qualification is selected. The second expert qualification is higher than the first expert qualification.

***Group VI***

The first expert qualification is transmitted to the second expert. A signal is received from the second expert. This signal indicates approval of the first expert qualification.

An end user request is received from an end user, and the first expert is selected based on the end user request.

At least a portion of the end user request is transmitted to the first expert. An expert answer is received responsive to the end user request. The expert answer contains information about the second expert. The expert answer is transmitted to the end user.

Payment is guaranteed to the first expert.

## **6.2. Advantages of Dependent Claim 186**

In addition to the advantages discussed above in Section 5.2 with respect to Group V, the embodiment of claim **186** provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

By *guaranteeing payment to the first expert*, experts are more willing to attempt to sell their services to end users, and are more willing to invest considerable time in high value services for end users. Thus, *guaranteeing payment to the first expert* overcomes several drawbacks of conventional systems for commerce in expert advice.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

## **6.3. No Prima Facie Showing of Unpatentability of the Claims of Group VI**

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

### 6.3.1. No showing that the references suggest *guaranteeing payment to the first expert*

The Examiner has not shown that the references, alone or in combination, suggest:  
*guaranteeing payment to the first expert*

As best as Appellants understand the rejection, the closest the Examiner comes to discussing this limitation is a conclusory statement that:

"These steps are obviously involved in the test: ... guaranteeing payment to the selected test (e.g., a test fee is administered in order to take the test or in order to have test results); therefore, the examiner submits that this step is obvious in a placement test"

Office Action mailed December 18, 2002, pages 10 - 11, par. 9.A.

#### No Substantial Evidence

First, as described above in the section entitled "The References", there is no evidence in the record for the USPTO material, or any other material in which one pays for a test, despite repeated requests from Appellants.

#### Do Not Suggest the Claim Limitation

More importantly, even if the Examiner's assertions were properly supported by substantial evidence, they would still not suggest this claim limitation.

According to the Examiner's interpretation, the payment by a test taker of a test fee suggests the claim limitation of *guaranteeing payment to the first expert*.

First, Appellants' understanding that full payment of test fees are required in advance of the test, otherwise registration is not permitted. There is no *guaranteeing of payment*.

Second, the test taker makes payment to the testing organization. This testing organization, for example, is not an *expert*, and is not *selected based on an end user request*. To the extent the test taker is considered the end user, the test taker does not provide a *request*, and an *expert answer* is not received responsive to any *request*. Finally, though the test taker may submit answers to test questions, the test taker is not an *expert* who thereafter is *guaranteed payment*.

#### **6.4. The Claims of Group II are Allowable Over the Cited References**

As described above, the Examiner has failed to provide a *prima facie* showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

##### **6.4.1. The references do not suggest *guaranteeing payment to the first expert***

No reference suggests:

*guaranteeing payment to the first expert*

No reference suggests that payment needs to be guaranteed, that payment is in danger of not being paid, or anything at all analogous to the claim limitation.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group VI, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group VI, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 6.2 "Advantages of Dependent claim 180". Accordingly, for at least those reasons, the claims of Group VI are patentable in view of the cited references.

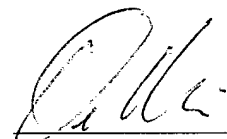
## CONCLUSION

Thus, the Examiner's rejection of the pending claims are is improper at least because the all pending claims are directed to statutory subject matter. In addition, the references, alone or in combination, do not disclose or suggest all the limitations of any claim. In addition, in the obviousness rejections the Examiner has improperly combined the references because there is no adequate reasoning or support in the prior art for making the proposed combination. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Dean Alderucci using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,



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September 23, 2003  
Date

**APPENDIX A**  
**CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL**

Claims 177 – 189 are pending and appealed.

Claims 177, 178, 179 and 185 are independent.

177. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

receiving a first expert qualification corresponding to a first expert;

selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;

transmitting the first expert qualification to the second expert; and

receiving a signal from the second expert that indicates approval of the first expert qualification.

CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL



178. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

- receiving a first expert qualification corresponding to a first expert;
- selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;
- transmitting the first expert qualification to the second expert;
- receiving a signal from the second expert that indicates approval of the first expert qualification; and
- incorporating identity data of the second expert into a key of the first expert.

179. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:
- receiving a first expert qualification corresponding to a first expert;
  - submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification;
  - receiving a signal from the set of experts that indicates approval of the first expert qualification;
  - receiving an end user request from an end user;
  - selecting the first expert based on the end user request;
  - transmitting at least a portion of the end user request to the first expert;
  - receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert; and
  - transmitting the expert answer to the end user.
180. The method of claim 179, further comprising:
- guaranteeing payment to the first expert.
181. The method of claim 180, wherein said guaranteeing payment to the first expert comprises:
- requiring the end user to prepay.

182. The method of claim 180, wherein said guaranteeing payment to the first expert comprises:  
  
checking a credit card account.

183. The method of claim 182, wherein said checking a credit card account is performed before said transmitting at least a portion of the end user request to the first expert.

184. The method of claim 182, further comprising:  
  
establishing a price for the expert answer corresponding to the end user request; and  
  
if credit available on the credit card account is less than the price of the expert answer, requesting that the end user provide a credit card number of another credit card account.

185. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

- receiving a first expert qualification corresponding to a first expert;
- selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;
- transmitting the first expert qualification to the second expert;
- receiving a signal from the second expert that indicates approval of the first expert qualification;
- receiving an end user request from an end user;
- selecting the first expert based on the end user request;
- transmitting at least a portion of the end user request to the first expert;
- receiving the expert answer responsive to the end user request; the expert answer containing information about the second expert; and
- transmitting the expert answer to the end user.

186. The method of claim 185, further comprising:  
guaranteeing payment to the first expert.

187. The method of claim 186, wherein said guaranteeing payment comprises:  
requiring the end user to prepay.

188. The method of claim 186, wherein said guaranteeing payment comprises:  
checking a credit card account.

CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL

189. The method of claim 188, wherein said checking a credit card account is performed before said transmitting at least a portion of the end user request to the first expert.

CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL

**APPENDIX B**  
**CHART SHOWING CLAIM DEPENDENCIES**

Claims 177 – 189 are pending and appealed.

Claims 177, 178, 179 and 185 are independent.

177			
178			
179			
└	180		
	└	181	
	└	182	
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		└	184
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└	186		
	└	187	
	└	188	
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CHART SHOWING CLAIM DEPENDENCIES

**APPENDIX C**  
**CHART SHOWING GROUP DEPENDENCIES**

Claims 177 – 189 are pending and appealed.

Claims 177, 178, 179 and 185 are independent.

<b>GROUP I</b> claim 177		
	<b>GROUP II</b> claim 178	
	<b>GROUP V</b> claim 185	
		<b>GROUP VI</b> claims 186 - 189
<b>GROUP III</b> claim 179		
	<b>GROUP IV</b> claims 180 - 184	

*CHART SHOWING GROUP DEPENDENCIES*